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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,561	03/27/2001	Larry L. Hood	155694-0054	2600
1622	7590	02/05/2004	EXAMINER	
IRELL & MANELLA LLP 840 NEWPORT CENTER DRIVE SUITE 400 NEWPORT BEACH, CA 92660			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3739	12

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/819,561

Applicant(s)

Hend

Examiner

D. J.

Group Art Unit

3739

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE — 3 — MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on November 21, 2003
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-34 & 36-44 is/are pending in the application.
- Of the above claim(s) 5-31 & 34 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-4, 32, 33, & 34-44 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sand.

See Figure 6.

Claims 1-4 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand in combination with Knopp et al. Sand teaches denaturing tissue. Knopp et al disclose a medical system that can denature a cornea comprising laser (item 87), a stepper motor (item 41), and a lens (item 17 and 23). The passages of column 1, line 59 – column 2, line 40 and column 8, lines 3-26 are particularly relevant to the claims at issue in regard to what the claims recite as a “focal point”. With appropriate positioning of the patient with respect to the device, the focal point will fall within the stroma. It would have been obvious to employ the laser of Sand in the device of Knopp et al, since this provides recurvature without tissue removal, as taught by Sand or to employ the focal point displacement mechanism of Knopp et al, since Sand provides no particulars of the mechanism for moving the beam, thus producing a device such as claimed.

Claims 32, 33, 35-38 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand in combination with Klopotek. Sand teaches denaturing eye tissue. Klopotek teaches configuring the intensity of an incident laser beam. It would have been obvious to the artisan of ordinary skill to employ the laser of Sand in the device of Klopotek, since this provides a non

Art Unit: 3739

destructive recurvature or to employ the intensity configuring mask of Klopotek in the device of Sand, since it will work equally well with any laser, thus producing a device such as claimed.

Claims 1, 40, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knopp et al in combination with Sand as applied to claims 1-4 and 40 are above, and further in view of L'Esperance Jr. L'Esperance Jr. teaches an ocular surgery device which provides for the movement of the beam focal point in a circular pattern about the cornea at a predetermined diameter. It would have been obvious to the artisan of ordinary skill to employ a scanner with a scan pattern as taught by L'Esperance, Jr., since this is a useful pattern for ophthalmic surgery and to produce the pattern with the diameter of 6-8 millimeters, since L'Esperance, Jr. says only that the distance needs to be "predetermined" and using a distance of 6-8 millimeters would place it outside of the optically used portion of the cornea, which will prevent visual distortions as is notorious in the art, thus producing a device such as claimed.

Claims 37 and 42-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sand in combination with Klopotek as applied to claims 32, 33, 35-38 and 42 above, and further in view of L'Esperance, Jr. L'Esperance, Jr. teaches providing a circularly scanned spot which denatures tissue. Thus it would have been obvious to the artisan of ordinary skill to employ the intensity modifier of Klopotek to produce the intensity pattern of the spot in the method of L'Esperance, Jr., since the outputs of laser such as used by L'Esperance, Jr. have a non-uniform intensity distribution, thus producing a method such as claimed.

Applicant's arguments with respect to claims 1-4, 32, 33, and 36-44 have been considered but are moot in view of the new ground(s) of rejection.

Application/Control Number: 09/819,561

Page 4

Art Unit: 3739

Any inquiry concerning this communication should be directed to David Shay at telephone number 308-2215.

A handwritten signature in black ink, appearing to read "David M. Shay" in a cursive style.

Shay/DI

January 21, 2004

DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330